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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,790	01/28/1999	EDWARD ELIZONDO	M-6353-HST-C	5870

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EXAMINER

FELTON, AILEEN BAKER

ART UNIT

PAPER NUMBER

3641

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED:

This is a communication from the examiner in charge of your application  
COMMISSIONER OF PATENTS AND TRADEMARKS

## Notice of Non—compliance with 35 U.S.C. 112 of application having SIR Request

An examination of the above identified application indicates that it does not comply with 35 U.S.C. 112 because:

[ ] 1. the specification does not contain a written description of the invention, and the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. (See attached sheet(s)).

Accordingly, claim(s) is/are rejected under 35 U.S.C. 112, first paragraph, as being based on an insufficient disclosure.

[ ] 2. the specification does not set forth the best mode contemplated by the inventor for carrying out the invention. (See attached sheet(s))

Accordingly, claim(s) \_\_\_\_\_ is/are rejected as being based on an insufficient disclosure.

[ X ] 3. the claims do not particularly point out or distinctly claim the subject matter which the applicant regards as the invention. Specifically claim(s) \_\_1, 13, and 15\_\_\_\_\_ are rejected as failing to comply with 35 U.S.C. 112, second paragraph. (See attached sheet(s))

[ ] 4. other; \_\_\_\_\_

[ ] Attachment, "Notice of Informal Statutory Invention Registration (SIR) Request".

A three month shortened statutory period is set for response to this action. This Period may be extended under 37 CFR 1.136. If no timely response is received, the application will be abandoned for failure to respond under 37 CFR 1.135. The Request for a Statutory Invention Registration will not be given further consideration until the application is amended to be in compliance with 35 U. S. C. 112.

Aileen B. Felton  
Aileen Felton  
Examiner, Group 3641  
Form PTO-SIR-I

Art Unit: 3641

***Election/Restriction***

1. Please indicate in the response if Applicant would prefer to have non-elected claims 17-20 published with the SIR. If Applicant does not want them published, please give permission for them to be canceled by examiner's amendment.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 recites the limitation "precisely measured" in step VI, line 22.. There is insufficient antecedent basis for this limitation in the claim. In claim 1, this is the first occurrence of this phrase so there is insufficient antecedent basis for this phrase and also it is unclear why Applicant is defining this phrase since it does not appear in the claim preceding this definition.

4. Claims 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 15 contain 2 Markush groups. The first group is improper because it recites "selected from the group consisting of molecules that each contain two distinct moieties". The group only contains one group member, i.e. molecules. The second Markush group is proper since it contains multiple group members. Perhaps deleting the first Markush group and

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substituting after component (B), “which are molecules that each contain two distinct moieties selected from the group consisting of hydroxyl, ether, and non-tetravalently bonded nitrogen moieties...”

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aileen Felton whose telephone number is (703) 306-5751. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*Aileen B. Felton*  
Aileen B. Felton